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| EXAMINER | |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/730,097 | EGUCHI ET AL. | |
| | Examiner | Art Unit | |
| | Dov Popovici | 2625 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *31 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh (U.S. Patent Application Publication (US 2002/0097443 A1) in view of Uchikawa (U.S. Patent No. 6,499,068).

Regarding claim 1, Itoh discloses a facsimile machine comprising:

means for scanning (7) an original document to generate image data;

means for detecting whether an amount of the image data exceeds a prescribed image data amount; (Fig. 1, item 3 Paragraph [0030] - division/reduction unit 3 is used to detect whether a size is exceeded. Note that the unit 3 judges whether or not a size in a main scanning direction of image information read by the scanner 7 is larger than an A3 size width which is a maximum width supposed to be communicable according to a communications protocol. The A3 size width which is a maximum width supposed to be communicable according to a communications protocol reads on “a prescribed image data amount”)

means for dividing (3) the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed amount; (Abstract and Paragraphs [0010 and 0030] - where the reading means determines that the width in a main scanning direction of a image bigger than A3. Also see Paragraph [0030]).

Itoh does not explicitly disclose "means for transmitting each divided image data by electronic mail."

Uchikawa discloses in Fig. 3 a mail transmissions component 3008 for e-mail transmissions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh by transmitting each divided image data by electronic mail.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh by the teaching of Uchikawa for at least one of the following reason(s): (1) transmitting each divided image data by electronic mail provides the user with a great deal of convenience and allowing the user to provide the image data directly into the receiver email or computer system; (2) transmitting image data by e-mail is an alternative and a substitute method of transmitting data as opposed to sending it by facsimile; (3) transmitting the image data by e-mail allows the user to receive the data in other remote locations (for example, a user's i-phone, blackberry, or laptop computer) or other remote electronic devices

where the user may have access to electronic mail and the user may not have access to a facsimile machine to receive the data by fax.

Regarding claim 2, Uchikawa discloses "wherein the means for transmitting further includes means for establishing a connection with a remote device when the scanning of the original document is started" (see column 3, lines 47-64).

Regarding claim 3, Uchikawa discloses wherein the means for transmitting further includes means for maintaining the connection with the remote device until all divided image data are transmitted (see column 3, lines 47-64).

Regarding claim 5, Itoh discloses a facsimile machine comprising:

means for scanning (7) an original document to generate image data;

means for detecting whether an amount of the image data exceeds a prescribed image data amount; (Fig. 1, item 3 Paragraph [0030] - division/reduction unit 3 is used to detect whether a size is exceeded. Note that the unit 3 judges whether or not a size in a main scanning direction of image information read by the scanner 7 is larger than an A3 size width which is a maximum width supposed to be communicable according to a communications protocol. The A3 size width which is a maximum width supposed to be communicable according to a communications protocol reads on “a prescribed image data amount”)

means for dividing the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed

image data amount; (Abstract and Paragraphs [0010 and 0030] - where the reading means determines that the width in a main scanning direction of a image bigger than A3. Also see Paragraph [0030]).

Itoh does not teach means for transmitting each divided image data by electronic mail, and means for stopping the transmission of the electronic mail when an error generates in the means for generating.

Uchikawa discloses "means for transmitting each divided image data by electronic mail" (see Uchikawa discloses in Fig. 3 a mail transmissions component 3008 for e-mail transmissions), and "means for stopping the transmission of the electronic mail when an error generates in the means for generating" (see column 10, lines 55-60 that when a job which cannot be simultaneously transmitted is decided as an error prior to the scanning operation, so that the vain scanning operation can be prevented. Thus, an e-mail would not be sent if a scanning procedure is not even finished. Also note in col. 10, lines 38-49, where a job which cannot be transmitted is accepted, it is determined that an error occurred).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh by providing means for transmitting each divided image data by electronic mail and by providing means for stopping the transmission of the electronic mail when an error generates in the means for generating.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh by the teaching of Uchikawa for at least one of the following reason(s): (1) transmitting each divided image data by electronic mail provides the user with a great deal of convenience and allowing the user to provide the image data directly into the receiver email or computer system; (2) transmitting image data by e-mail is an alternative and a substitute method of transmitting data as opposed to sending it by facsimile; (3) transmitting the image data by e-mail allows the user to receive the data in other remote locations (for example, a user's i-phone, blackberry, or laptop computer) or other remote electronic devices where the user may have access to electronic mail and the user may not have access to a facsimile machine to receive the data by fax; (4) in case of an error occurrence, stopping the transmission of the electronic mail when an error occurred; (5) if a job which cannot be transmitted is accepted, it is determined that an error occurred and the processes are stopped (as taught by Uchikawa at col. 10, lines 38-60).

Regarding claim 6, Itoh discloses a facsimile machine comprising:

means for scanning (7) an original document to generate image data;

means for detecting whether an amount of the image data exceeds a prescribed image data amount; (Fig. 1, item 3 Paragraph [0030] - division/reduction unit 3 is used to detect whether a size is exceeded. Note that the unit 3 judges whether or not a size in a main scanning direction of image information read by the scanner 7 is larger than an A3 size width which is a maximum width supposed to be communicable according to

a communications protocol. The A3 size width which is a maximum width supposed to be communicable according to a communications protocol reads on "a prescribed image data amount")

means for dividing the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed image data amount; (Abstract and Paragraphs [0010 and 0030] - where the reading means determines that the width in a main scanning direction of a image bigger than A3. Also see Paragraph [0030]).

Itoh does not teach means for transmitting each divided image data by electronic mail, and means for stopping the scanning of the original document when an error generates in the means for transmitting.

Uchikawa discloses "means for transmitting each divided image data by electronic mail" (see Uchikawa discloses in Fig. 3 a mail transmissions component 3008 for e-mail transmissions), and "means for stopping the scanning of the original document when an error generates in the means for transmitting" (see column 10, lines 55-60 that when a job which cannot be simultaneously transmitted is decided as an error prior to the scanning operation, so that the vain scanning operation can be prevented. Thus, an e-mail would not be sent if a scanning procedure is not even finished. Also note in col. 10, lines 38-49, where a job which cannot be transmitted is accepted, it is determined that an error occurred).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh by providing means for transmitting each divided image data by electronic mail and by providing means for stopping the scanning of the original document when an error generates in the means for transmitting.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh by the teaching of Uchikawa for at least one of the following reason(s): (1) transmitting each divided image data by electronic mail provides the user with a great deal of convenience and allowing the user to provide the image data directly into the receiver email or computer system; (2) transmitting image data by e-mail is an alternative and a substitute method of transmitting data as opposed to sending it by facsimile; (3) transmitting the image data by e-mail allows the user to receive the data in other remote locations (for example, a user's i-phone, blackberry, or laptop computer) or other remote electronic devices where the user may have access to electronic mail and the user may not have access to a facsimile machine to receive the data by fax; (4) in case of an error occurrence, stopping the scanning of the original document when an error has occurred or generated in the means for transmitting (so as to avoid waste in time and to reduce the wear and tear of the scanning device) and so that the error can be corrected before the scanning is resumed; (5) if a job which cannot be transmitted is accepted, it is determined that an error occurred and the processes (i.e., scanning) are stopped (as taught by Uchikawa at col. 10, lines 38-60).

Regarding claim 7, Uchikawa discloses means for storing the electronic mail; (Fig. 1, database/mail server 1004) and means for retransmitting the electronic mail by outputting the electronic mail from the means for storing when it is determined that the electronic mail can be retransmitted based on contents of the error (see column 10, lines 10-18, a retry can occur if the number of destinations exceeds the amount of jobs that can be simultaneously processed).

Regarding claim 8, Uchikawa discloses means for stopping the scanning of the original document and the transmission of the electronic mail when it is determined that the electronic mail cannot be retransmitted based on contents of the error (see column 10, lines 55-60 that when a job that cannot be simultaneously transmitted is decided as an error, then scanning is prevented because it would be in vain.)

Regarding claim 9, Itoh discloses a facsimile machine comprising:

means for scanning (7) an original document to generate image data;

means for detecting whether an amount of the image data exceeds a prescribed amount; (see paragraphs [0042], [0051] discloses a control unit 31 generates the break signal for dividing image data.)

means for dividing the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed amount; (paragraph [0042] - a plurality of image files are created when input data is broken at prescribed breaks) .

Itoh does not teach means for transmitting each divided image data by electronic mail; means for providing the electronic mail with information regarding an error when detecting the error in the transmitted electronic mail; and means for retransmitting the electronic mail.

Uchikawa discloses "means for transmitting each divided image data by electronic mail; means for providing the electronic mail with information regarding an error when detecting the error in the transmitted electronic mail; and means for retransmitting the electronic mail "(see Fig. 3 a mail transmissions component 3008 for email transmissions. See column 10, lines 10-18 that error information is shown and a retry is performed.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh by providing means for transmitting each divided image data by electronic mail; means for providing the electronic mail with information regarding an error when detecting the error in the transmitted electronic mail; and means for retransmitting the electronic mail.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh by the teaching of Uchikawa for at least one of the following reason(s): (1) transmitting each divided image data by electronic mail provides the user with a great deal of convenience and allowing the user to provide the image data directly into the receiver email or computer system; (2) transmitting image data by e-mail is an alternative and a substitute method of

transmitting data as opposed to sending it by facsimile; (3) transmitting the image data by e-mail allows the user to receive the data in other remote locations (for example, a user's i-phone, blackberry, or laptop computer) or other remote electronic devices where the user may have access to electronic mail and the user may not have access to a facsimile machine to receive the data by fax; (4) in case of an error occurrence, providing the email with information regarding an error when detecting an error in the transmitted email, so that the user will be notified of the occurrence of an error; (5) after on occurrence of an error, and a correction or fixing of the error, retransmitting the email to the user so that the user can receive the required or needed information.

Regarding claim 10, Uchikawa discloses means for storing the electronic mail; (Fig. 1, database/mail server 1004) and means for retransmitting the electronic mail by outputting the electronic mail from the means for storing when it is determined that the electronic mail can be retransmitted based on contents of the error (see column 10, lines 10-18 - a retry can occur if the number of destinations exceeds the amount of jobs that can be simultaneously processed).

Regarding claim 11, Uchikawa discloses means for stopping the scanning of the original document and the transmission of the electronic mail when it is determined that the electronic mail cannot be retransmitted based on the contents of the error (see column 10, lines 55-60 that when a job that cannot be simultaneously transmitted is decided as an error, then scanning is prevented because it would be in vain. Thus, a email would not be sent if a scanning procedure is not even finished. Also note in 10, lines 38-49, a job can be decided to be unable to be transmitted.)

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh (U.S. PG Pub. No. 2002/0097443) in view of Uchikawa (U.S. Patent No. 6,499,068) and further in view of Oteki et al (U.S. PG. Pub No. 20010019429).

Regarding claim 4, Itoh as modified by Uchikawa discloses means for storing the electronic mail, means for receiving information regarding reception of the electronic mail from the remote device (see paragraphs [0052-0056] -image data is divided to be scanned and then stored. Transmitted data is also stored in storage unit 23).

Itoh as modified by Uchikawa do not explicitly disclose "means for erasing the electronic mail from the means for storing when it is determined that the remote device received the electronic mail normally in accordance with the information received from the remote device."

Oteki discloses in paragraph [0160] that data that is completely sent is deleted from the image memory.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh as modified by deleting the completed sent transmission image data from the memory.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh as modified by Oteki so that the completed sent transmission image data is deleted from the memory in order to provide memory space in the memory for future incoming image data and/or electronic mails.

The motivation would have been to free up memory space for storing future incoming data.

Claims 12-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh (U.S. PG Pub. No. 20040030684) in view of Uchikawa (U.S. Patent No. 6,499,068) and further in view of Tanimoto (U.S. PG Pub. No. 20020131089) .

Regarding claim 12, Itoh as modified by Uchikawa discloses a facsimile machine comprising:

means for scanning (7) an original document to generate image data;

means for detecting whether an amount of the image data exceeds a prescribed amount; (P[0042], P[0051] discloses a control unit 31 generates the break signal for dividing image data.)

means for dividing the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed amount; (P[0042] - a plurality of image files are created when input data is broken at prescribed breaks)

means for transmitting each divided image data by electronic mail; (P[0041] disclose that email is one of the mean for transfer).

However, Itoh as modified by Uchikawa do not explicitly disclose "means for providing the electronic mail with information indicating a transmission number of the electronic mail."

Tanimoto discloses in Fig. 8 various emails being sent with respective transmission numbers (see figure 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh as modified to include means for providing the electronic mail with information indicating a transmission number of the electronic mail.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Itoh as modified by the teachings of Tanimoto in order to include means for providing the electronic mail with information indicating a transmission number of the electronic mail so that the end user or the receiver would know the number of files or emails being transmitted (i.e., the motivation would have been to given a number to emails so that it is known how many mail pieces to expect) and so that the image data is divided and transmitted in plural smaller e-mails (known to the user how many emails to except) in order to avoid an error in transmission or an error in reception of a single large email.

Regarding claim 13, Tanimoto discloses means for providing the electronic mail with information indicating whether subsequent electronic mail will be transmitted (Tanimoto discloses in Figs. 8 and 9 and P[0095-0096] that there is a command that is

sent from the sending fax to the receiving fax. This can designate a print order or forwarding order. Since there is a designation of the order, then it would be obvious that subsequent emails will be transmitted given, for example, the first email is transmitted and the designation of order calls for three emails).

Regarding claim 14, Tanimoto discloses means for providing the electronic mail with information indicating a total number of the electronic mails (see Tanimoto, discloses in Fig. 8 that there is a total number of 3 files).

Regarding claim 15, Tanimoto discloses means for providing the electronic mail with page information of the original document. (see Tanimoto, discloses in P[0091] that info is provided of how many pages the image data of the file name has, see paragraph 0091).

***Response to Arguments***

Applicant's arguments filed 10/31/2008 have been fully considered but they are not persuasive.

Applicant argues that it is submitted that the reference Itoh fails to disclose or fairly suggest the features of claim 1, as amended, concerning the, *"means for detecting whether an amount of the image data exceeds a prescribed image data amount," means for dividing the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed image data amount."*

Applicant further argues that Itoh teaches a division/reduction unit for the particular purpose of determining the *physical* paper size (width) of a page to be scanned and then deciding whether to divide or reduce that page. See, Itoh, P[0030]. The division process includes a division of the image data into divisional lines of data. See, Itoh, Abstract. The division/reduction in Itoh is based on an assessment of the *physical* size of the document.

However, applicant also argues that Itoh fails to disclose or fairly suggest the checking of a prescribed *image data* amount, and instead decides whether to take action based on the *physical* size of the paper to be scanned.

Therefore, the Itoh reference fails to teach the "means for detecting" feature of claim 1, as amended.

Additionally, Itoh teaches a facsimile device, specifically for inputting image data of a subject copy having a width in a main scanning direction larger than an A3-size width. The facsimile device of Itoh takes the subject copy that is bigger than an A3-size width and reduces *the physical* size of the subject copy. See, Abstract and P[0010], P[0030] of Itoh.

Itoh does not disclose or fairly suggest dividing the image data based on a prescribed *image data* amount for the purpose of making the *image data* more manageable to transmit. Instead, Itoh teaches reducing *the physical* size of the subject copy (the width).

In view of the above, it is submitted that Itoh does not teach or fairly suggest the features of claim 1 regarding a *"means for detecting whether an amount of the image data exceeds a prescribed image data amount" and a "means for dividing the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed image data amount."*

Applicant arguments have been fully considered, but they are not found to be pervasive because of the following reason(s):

Itoh discloses means for detecting whether an amount of the image data exceeds a prescribed image data amount; (see Fig. 1, item 3 and paragraph [0030] – The division/reduction control unit 3 judges whether or not a size in a main scanning direction of image information read by the scanner 7 is larger than an A3 size width which is a maximum width supposed to be communicable according to a communications protocol (see Itoh at paragraph 0030). The amount of image data found in the A3 size width which is a maximum width supposed to be communicable according to a communications protocol reads on "a prescribed image data amount").

Therefore, Itoh discloses means for detecting whether an amount of the image data exceeds a prescribed image data amount; (Fig. 1, item 3 Paragraph [0030] - division/reduction unit 3 is used to detect whether a size is exceeded. Note that the unit 3 judges whether or not a size in a main scanning direction of image information read by the scanner 7 is larger than an A3 size width which is a maximum width supposed to be communicable according to a communications protocol. The A3 size width which is a

maximum width supposed to be communicable according to a communications protocol reads on "a prescribed image data amount") and means for dividing (3) the image data in parallel with the scanning of the original document each time the amount of the image data is detected to exceed the prescribed amount; (Abstract and Paragraphs [0010 and 0030] - where the reading means determines that the width in a main scanning direction of a image bigger than A3. Also see Paragraph [0030]).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dov Popovici whose telephone number is 571-272-4083. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dov Popovici/
Primary Examiner, Art Unit 2625